

REMARKS

The Applicants have reviewed the Office Action dated October 27, 2005 in which the claims were not compliant under 37 CFR 1.121, which responded to the Applicant's bona fide attempt to reply to a Final Office action on April 6, 2005. This amendment with the following remarks is a substitute and a replacement for the Applicant's Preliminary Amendment filed on April 6, 2005. The Applicants respectfully submit that the Notice of Non-Compliant Amendment should be withdrawn.

By virtue of this amendment, claims 9-10, 12-16, and 23-30 are pending in the application. Claims 9-10, 14-15, 23, and 27 have been amended. Claims 1-8, 11, and 17-22 have been cancelled. An examination of this application is respectfully requested in light of this preliminary amendment and the present remarks.

On January 14, 2005, the Examiner issued a **final** Office Action on the application (09/757,901) to which this Request for Continuing Examination claims priority. In the **final** Office Action, the Examiner rejected claims 9, 10, 14-16, 23, 24, 27 and 28 under 35 U.S.C. 103(a) as being unpatentable over Herz et al. (U.S. Patent No. 6,571,279) in view of Dowling et al. (U.S. Patent No. 6,522,875).

Independent claims 9 and 14 have been amended to recite, and Independent claims 23 and 27 do recite, the following:

determining the presence of at least one item inside a sales location, the item being identified within the user profile data;

generating a personalized advertisement which includes one of:

a map providing directional information to an inner position within the sales location of the at least one item in response to the at least one item being present inside the sales location; and

a map providing directional information of an inner aisle layout of the sales location in response to the at least one item being not present within the sales location... (emphasis

added)

The present invention is directed to a combination of Global Positioning System (GPS), Personal Data Assistant (PDA), and wireless communications in order to create a more personalized advertising experience. The invention creates and presents advertising content founded on individual user profiles integrated with the physical geographic location of a consumer. The present invention solves the problem of advertising tailored so that it is appropriate to both the user and their current location by including a customer's profile and his / her current location into the advertising message. Also, the invention integrates location tracking, e.g. GPS technology, with a personal electronic calendaring system. Further, an advertising message is more personalized by using a relative address / directions that start from the current customer's location. **This information can be provided in the form of driving directions or a map, using the current physical position of the user as a start address.** See Abstract of the specification of the Applicants' invention and page 26, third para.

As the Examiner recognizes, on page 3 of the Office action, the Herz reference does not teach "generating a personalized advertisement which includes a map." The Examiner then goes on to combine Dowling et al.¹

The Dowling reference does show the generation of directions and/or a map based on the content of a user profile. However, Dowling only gives an example of directions to, and a map of, the inside of a shopping mall to locate a store. Dowling, col. 14, line 58 – col. 15, line 10.

However, the Dowling reference does not teach rendering a map to an item's inner position within a sales location if the item is determined to be in stock and, alternatively, rendering a map of an aisle layout within a sales location if the item is out

¹ Applicants make no statement whether such combination is even proper.

of stock.

The specification of the instant application discloses that "the invention can also provide directions within a large building (e.g. a shopping mall), or within a store (direction to the desired product, which aisle or shelf the product or service is in or the equivalent)." Page 8, first paragraph and FIG. 7, items 726-734 and pages 24-26 referring to FIG. 7. Therefore, the user is provided with a map that will guide them directly to the exact item's location within a store if the item is in stock. Alternatively, the user is provided with a map of the interior aisle layout of the store if the item is not in stock. Accordingly, independent claims 9, 14, 23, and 27 distinguish over Hertz taken alone and/or in view of Dowling for at least this reason.

The Examiner recites 35 U.S.C. § 103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter as a whole and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention as a whole. Herz et al. taken alone and/or in view of Dowling et al. simply does not teach or suggest "a map providing directional information to an inner position within the sales location of the at least one item in response to the at least one item being present inside the sales location; and a map providing directional information of an inner aisle layout of the sales location in response to the at least one item being not present within the sales location."

Continuing further, when there is no suggestion or teaching in the prior art for that disclosed in the application, the suggestion cannot come from the Applicants' own specification. As the Federal Circuit has repeatedly warned against using the Applicants' disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

It is accordingly submitted that Herz et al., whether taken alone or in combination with Dowling et al., neither shows nor suggests the features of claims 9, 14, 23 or 27. Claims 10 and 12-13 depend from claim 9; claims 15-16 depend from claim 14; claims 24-26 depend from claim 23; and claims 28-30 depend from claim 27. Since dependent claims contain all the limitations of the independent claims, claims 10, 12-13, 15-16, 24-26, and 28-30 distinguish over Herz et al. and Dowling et al., as well.

No new matter has been added. This preliminary amendment has been filed to place the application in better form for examination. An action on the merits is respectfully requested.

CONCLUSION

In this Preliminary Amendment, Applicants have amended certain claims. Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

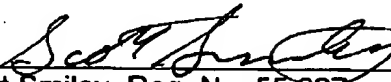
Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.


Respectfully submitted,

Date: November 9, 2005

By:


Scott Smiley, Reg. No. 55,627
Attorney for Applicants

By:


Jon Gibbons, Reg. No. 37,333
Attorney for Applicants

FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO P.L.
551 N.W. 77th Street, Suite 111
Boca Raton, FL 33487
Tel (561) 989-9811
Fax (561) 989-9812

Please Direct All Future Correspondence to Customer Number **23334**

ARC9-2000-0048-US1

12